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10/779,767

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EXAMINER

CHU, KIM KWOK

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/779,767	Applicant(s) KO ET AL.	
	Examiner KIM CHU	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 1/4/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18 and 20 is/are rejected.
- 7) ☒ Claim(s) 17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/18/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/333,520.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Remarks

1. Applicant's Remarks filed on January 4, 2008 has been fully considered but it is not persuasive.

With respect to the 35 U.S.C. § 102(e) rejection on Claims 1 and 13, Applicant states that the prior art of Ro et al. (U.S. Patent 6,288,989) does not teach a recording of a plurality of identical overwrite prevention information (page 7 of the Remarks, lines 5 and 6). Referring to Ro's Fig. 6, Applicant points out that each audio/video program has only one corresponding recording of overwrite prevention information (page 7 of the Remarks, lines 7 and 8). Accordingly, Applicant's plurality of write protection information do not specify whether it is for one program or for different programs. On the other hand, the word "program" is just a name to distinguish various stored information. For example, in Applicant's disc, there are various stored information similar to Ro's programs and both Applicant and the prior art of Ro utilize a plurality of overwrite prevention information to protect such programs.

Furthermore, Applicant argues that the prior art of Ro's passwords is not write protection information (page 7 of the Remarks, lines 11 and 12). Accordingly, a password is a kind of protection information so that an unauthorized write/read operation is prohibited. Since Applicant's amended Claim 1 does not specify

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how the information is protected, a password such as Ro's fulfill the limitation of write protection as required in the present amended Claim 1.

Regarding the rejection of Claim 13, Applicant states that the prior art of Ro's plurality of overwrite prevention information is not recorded at the same time as required in Claim 13 (page 7 of the Remarks, second paragraph, lines 5 and 6). Accordingly, Ro's passwords as illustrated in Fig. 6 are recorded at the same time during the recording of the programs. Although the passwords are not recorded simultaneously, they are recorded together with the programs similar to Applicant's recording of the write protection information.

Independent Claims 1, 2, 5, 8, 12 and 13 are rejected based on above response to Applicant's Remarks.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 19 of the '713 patent contains all of the features of the above mentioned claim 1.

4. Claims 2-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 9 of the '713 patent contains all of the features of the above mentioned claims 2-4. For example:

(a) as in claim 4, the recording medium is a bare disc not contained in a case or cartridge (DVD-R is a bare disc).

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5. Claims 5-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, 36 and 40 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 32, 36 and 40 of the '713 patent contains all of the features of the above mentioned claims 5-7.

6. Claims 8-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 15 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14 and 15 of the '713 patent contains all of the features of the above mentioned claims 8-11.

7. Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the '713 patent contains all of the features of the above mentioned claim 12. For example:

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(a) with respect to the present Claim 12, the claimed feature "write protection information being redundantly stored" is the stored passwords as claimed in Claim 1 of the '713 patent; and

(b) the DVD-R and/or DVD-RW limitation in the present Claim 12 is the DVD specification as claimed in Claim 1 of the '713 patent.

8. Claims 13-16, 18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 9 of the '713 patent contains all of the features of the above mentioned claims 13-16, 18 and 20. For example:

(a) as in claim 13, the limitation "recording management data area" is the "Lead-in area" cited in Claim 1 of the '713 patent.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

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10. Claims 1 and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ro et al. (U.S. Patent 6,288,989).

11. Ro teaches a write protection method for an optical disc recording and/or reproducing apparatus having all the steps as cited in claim 1. For example, Ro teaches the following:

(a) with respect to Claim 1, checking write protection information stored in an RMD (Recording Management Data) field of a RMA (Recording management Area/Lead-in) area to protect data recorded on the recording medium from unwanted overwriting or erasing (Fig. 6; password protection) and prohibiting writing of data on the recording medium according to the write protection information (Figs. 3-5), wherein the write protection information is redundantly stored in physically separate locations (Fig. 6; multiple passwords are stored in the Lead-in medium management area).

12. Apparatus claim 13 is drawn to the apparatus corresponding to the method of using same as claimed in claim 1. Therefore apparatus claim 13 corresponds to method claim 1, and is rejected for the same reasons of anticipation as used above. Claim 13 however also recites the following limitation which is also taught by the prior art of Ro:

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(a) with respect to Claim 13, a user area (Fig. 6; data area is the user area).

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

14. Claims 8 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Takahashi (U.S. Patent 6,236,541).

Takahashi teaches a storage device having all of the elements and means as recited in claims 8 and 9. For example, Takahashi teaches the following:

(a) with respect to Claim 8, the storage device comprising: a recordable and/or rewritable recording medium 5 including a Lead-in area; a Lead-out area; and a user data area (Fig. 4; column 4, lines 25 and 26); and a cartridge 4 having a case which receives the recording medium 5 (Fig. 4); wherein the recording medium 5 is set to a write protection state (Fig. 4; with preventive member 27) ensuring the protection of data, including the entire user data area or at least a plurality of particular data files, recorded on the recording medium from unwanted overwriting or erasing, when the finalization (recording is done and the medium can be ejected) for

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writing on the Lead-in area and the Lead-out area has been completed (Fig. 4; column 6, lines 43-53).

(b) with respect to Claim 9, the case has a recognition switch 27 for write protection (Fig. 4).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ro et al. (U.S. Patent 6,288,989) and further in view of Yonemitsu et al. (U.S. Patent 5,793,779).

17. Ro teaches a recordable and/or rewritable recording medium to record data very similar to that of the instant invention as in Claims 2 and 4. For example, Ro teaches the following:

(a) as in claim 2, the medium has an entire user data area or at least a plurality of particular data files (Fig. 6); a Lead-in area (Fig. 6); wherein upon the finalization (updating) for writing

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on the Lead-in area has been completed, the recording medium is set to a write protection state ensuring the protection of the data recorded on the recording medium from unwanted overwriting or erasing (Figs. 2A and 4; each program can be set to a protected mode or non-protected mode).

However, Ro does not teach that the recording medium has a Lead-out area during a finalization stage.

Yonemitsu et al. teaches a recording medium having a Lead-out area (Fig. 5).

Although Ro does not teach a Lead-out area in his recording medium, the Lead-out area is not a novel medium specification. For example, Yonemitsu teaches an optical recording medium having a Lead-out area as an information reserve region. Hence, when there is a motivation of storing file management data, it would have been obvious to one of ordinary skill in the art at the time of invention to divide an optical recording medium into a Lead-in area, a Lead-out area and a user data such as Applicant's and Yonemitsu's, because the Lead-out area can be used as an additional region for updating/finalizing management information other than user data.

b) as in Claim 4, the recording medium 10 is a bare disc not contained in a case of a cartridge (Fig. 1).

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18. Apparatus claim 5 is drawn to the apparatus corresponding to the method of using same as claimed in claim 2. Therefore apparatus claim 5 corresponds to method claim 2, and is rejected for the same reasons of anticipation as used above. Claim 5 however also recites the following limitation which is also taught by the prior art of Ro:

(a) with respect to Claim 5, a user area (Fig. 6; data area is the user area).

Allowable Subject Matter

19. Claims 17 and 19 are objected to as being dependent upon rejected claims based on obvious double patenting, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 17, the prior art of record considered as a whole fails to teach or fairly suggest a recording medium having a recording information area, distinct from the Lead-in area, the Lead-out area and the user data area, and including RMD fields, wherein the RMD fields store information indicative of pre-use certification and defect management in use.

Regarding claim 19, the prior art of record considered as a whole fails to teach or fairly suggest a recording medium having write protection information which is stored in a byte position BP3 of RMD field 0, and information indicative of types of recording

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medium, indicating whether the recording medium satisfies the DVD-RW specification, is stored in byte positions BP0 and BP1 of the RMD field 0.

The features indicated above, in combination with the other elements of the claims, are not anticipated by, nor made obvious over, the prior art of record.

20. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

/Kim-Kwok CHU/

Examiner AU2627

March 28, 2008
(571) 272-7585

/HOA T NGUYEN/
Supervisory Patent Examiner, Art Unit 2627